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APPLICATION NO. 09/545,072	FILING DATE 04/07/2000	FIRST NAMED INVENTOR Yun Lin	ATTORNEY DOCKET NO. 00786/368002	CONFIRMATION NO. 9768
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EXAMINER KUBELIK, ANNE R

ART UNIT 1638	PAPER NUMBER
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DATE MAILED: 12/20/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/545,072

Applicant(s)

LIN ET AL.

Examiner

Anne R. Kubelik

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 November 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. THEREFORE, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in a condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
 ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 27 November 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
 2. ☐ The proposed amendment(s) will not be entered because:
 (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ they raise the issue of new matter (see Note below);
 (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
 4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
 6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
 7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1.3-13 and 15-26.

Claim(s) withdrawn from consideration: 14 and 27-39.

8. ☒ The proposed drawing correction filed on 27 November 2002 is a) ☒ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
 10. ☒ Other: See Continuation Sheet

Continuation of 2. NOTE: New issues: Claim 23 is indefinite in its recitation of "based on a nucleic acid" It is not clear what it means for an antisense RNA to be based on a nucleic acid - does it mean it differs from it in some manner?

Continuation of 3. Applicant's reply would have overcome the following rejection(s):

The 102(b) rejections of claims 8 and 11-12 as anticipated by Storozhenko et al and claims 23-26 as anticipated by Lee et al and the 1-3(a) rejection over lee et al in view of Storozhenko et al would be withdrawn in light of amendment to indicate that the nucleic acid encodes a protein with 30% identity to SEQ ID NO:2.

The 102(b) rejection of claim 21 as anticipated by Akama would be withdrawn in light of amendment to indicate that the seed comprises the nucleic acid.

Continuation of 5. does NOT place the application in condition for allowance because:

112, 1st enablement rejections: Claim 1 is drawn to a nucleic acid encoding any protein with 30% identity to SEQ ID NO:2. The specification does not teach how to use any such protein - it only teaches how to use SSE proteins. Making nucleic acids that encode proteins with 30% identity to SEQ ID NO:2 would require making 256 amino acid substitutions. The specification fails to provide guidance for making such a nucleic acid that also encodes a protein that facilitates the intracellular transport of a protein, the formation of protein bodies, or the formation of oil bodies. Without that guidance, undue experimentation would be required, simply based on the astronomical numbers of possible nucleic acids to be made and analyzed. Colliver et al teaches the importance of sequence identity between an antisense RNA and the target gene - thus, SEQ ID NO:1 could only be used in antisense inhibition in Arabidopsis, and it is not clear in what plant a nucleic acid that encodes a protein with 30% identity to SEQ ID NO:2 could be used.

112, 1st written description: The specification does not describe the structural features of a nucleic acid that encodes a protein that has 30% identity to SEQ ID NO:2 and that encodes a protein that facilitates the intracellular transport of a protein, the formation of protein bodies, or the formation of oil bodies.

112, 2nd: hybridization conditions are indefinite because hybridization and wash times are not specified.

Continuation of 10. Other: This application contains claims 14 and 27-39 drawn to an invention nonelected without traverse in Paper No. 11. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

DAVID T. FOX
PRIMARY EXAMINER
GROUP 180

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